



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/616,219	07/14/2000	Timothy B. Demers	42472.1	7012

22859 7590 04/19/2004

INTELLECTUAL PROPERTY GROUP
FREDRIKSON & BYRON, P.A.
4000 PILLSBURY CENTER
200 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402

EXAMINER

PHAN, TAM T

ART UNIT	PAPER NUMBER
----------	--------------

2144

DATE MAILED: 04/19/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/616,219

Applicant(s)

DEMERS ET AL.

Examiner

Tam (Jenny) Phan

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date Z.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Amendment A, paper #6, received on 02/17/2004 has been entered into record. Claims 1-8 were present in the original filing of the application. Claims 1-3 and 6-8 are amended, claims 4-5 are original, and claims 9-17 are newly added.
2. Claims 1-17 remain pending.

Priority

3. No priority claims have been made.
4. The effective filing date of the claimed invention is July 14, 2000.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 2, 8-9, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Regarding claim 2, the phrase "in the form of access to a dedicated and/or affiliated server" renders the claim indefinite because it is unclear whether the limitations before and after the "and/or" is part of the claimed invention.
8. Regarding claims 8 and 9, the phrase "access the for related content" is causing difficult for the Office to interpret the claimed invention.
9. Regarding claim 16, the claim read "A method according to claim 16", this is indefinite because claim 16 is depended upon itself.

10. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. For examining purposes, these claims will be treated as independent claims.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-2, 4, and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Shoff et al. (U.S. Patent No. 6,240,555), hereinafter referred to as Shoff.

12. Regarding claim 1, Shoff disclosed a computer program for controlling a computer, the program comprising a recording medium readable by the computer, the recording medium itself comprising means for providing both a multimedia player component and an integrated Internet browser component, wherein the program permits a user to play one or more items of multimedia and to access the Internet in an integrated fashion (Title, Figures 2-4, 8C, column 1 lines 47-51 and lines 57-63, column 3 lines 1-14, lines 18-38, column 5 lines 13-33, lines 49-60, column 7 lines 9-17, lines 26-35, column 9 lines 30-59).

13. Regarding claim 2, Shoff disclosed said access of the Internet is provided in the form of access to a dedicated and affiliated server sites adapted to provide related content (Figure 4, column 7 lines 26-35).

14. Regarding claim 4, Shoff disclosed a computer program further comprising one or more items of multimedia content (column 1 lines 47-51).

Art Unit: 2144

15. Regarding claim 6, Shoff disclosed an article or manufacture for use in a computer, comprising a digital recording medium [CD-ROM] comprising computer program for controlling the computer, the program comprising a recording medium readable by the computer, the recording itself comprising means for providing both a multimedia player component and an integrated Internet browser component, wherein the program permits a user to play one or more items of multimedia and to access the Internet in an integrated fashion (Title, Figures 2-4, 8C, column 1 lines 47-51 and lines 57-63, column 3 lines 1-14, lines 18-38, column 5 lines 13-33, lines 49-60, column 7 lines 9-17, lines 26-35, column 9 lines 30-59).

16. Regarding claim 7, Shoff disclosed a system comprising a computer program for controlling the computer, the program comprising a recording medium readable by the computer, the recording medium itself comprising means for providing both a multimedia player component and an integrated Internet browser component, wherein the program permits a user to pay one or more items of multimedia and to access the Internet in an integrated fashion, in combination with a dedicated server adapted to be linked by the browser in order to provide related content (Title, Figures 2-4, 8C, column 1 lines 47-51 and lines 57-63, column 3 lines 1-14, lines 18-38, column 5 lines 13-33, lines 49-60, column 7 lines 9-17, lines 26-35, column 9 lines 30-59).

17. Regarding claim 8, Shoff disclosed a method of providing multimedia, the method comprising the steps of providing a computer program, for controlling the computer, the program comprising a recording medium readable by the computer, the recording medium itself comprising means for providing both a multimedia player component and

Art Unit: 2144

an integrated Internet browser component, wherein the program permits a user to play one or more items of multimedia and to access the Internet in an integrated fashion, loading the computer program on a client computer, establishing a connection between the Internet and the client computer, and employing the program to both play one or more items of multimedia content and access the Internet for related content (Title, Figures 2-4, 8C, column 1 lines 47-51 and lines 57-63, column 3 lines 1-14, lines 18-38, column 5 lines 13-33, lines 49-60, column 7 lines 9-17, lines 26-35, column 8 lines 35-41, column 9 lines 30-59).

18. Since all the limitations of the claimed invention were disclosed by Shoff, claims 1-2, 4, and 6-8 are rejected.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 3, 5, and 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff as applied above in view of Fidelibus et al. (U.S. Patent Number 5,931,906), hereinafter referred to as Fidelibus.

21. Regarding claim 3, Shoff disclosed a computer program for controlling a computer, [and] for providing both a multimedia player component and an integrated internet browser component, wherein the program permits a user to play one or more items of multimedia and to access the internet in an integrated fashion (Title, Column 1

lines 47-51 and lines 57-63). Shoff further disclosed access of the internet is provided in the form of access to a dedicated and affiliated server sites adapted to provide related content (Figure 4, column 7 lines 26-35).

22. Shoff did not disclose access to the Internet, which further comprises a conventional browser in order to provide access to unaffiliated server sites. However, in an analogous art, Fidelibus disclosed means for user to access the Internet to surf other features of the Web site (column 8 lines 9-18).

23. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include a conventional browser in order to provide access to unaffiliated server sites in order to give users more flexibility. This feature will allow users to enjoy the multimedia component and its supplemental content while able to access the Internet for further user actions such as view credit card statement, pay bills, etc. (column 8 lines 21-24).

24. Regarding claim 5, Fidelibus disclosed a computer program wherein the multimedia content is selected from music and corresponding video and graphics (column 2 lines 57-64).

25. Regarding claims 9, 12, and 15, Shoff and Fidelibus combined disclose an article, a system, a method wherein access to the Internet is provided in the form of access to a dedicated and affiliated server sites adapted to provide related content, and further comprises a conventional browser in order to provide access to unaffiliated server sites (Shoff, Figure 4, column 7 lines 26-35; Fidelibus, Figure 3, column 4 lines 64-67, column 5 lines 1-20, column 8 lines 21-24).

Art Unit: 2144

26. Regarding claims 10, 13, and 16, Fidelibus disclosed an article, a system, and a method further comprising one or more items of multimedia content selected from music and corresponding video and graphics (column 2 lines 57-64).

27. Regarding claims 11, 14, and 17, Fidelibus disclosed an article, a system, and a method wherein the digital recording medium comprises both audio/video/graphics and the software application on the same digital medium (column 2 lines 11-26, lines 50-67, column 5 lines 1-20).

28. Since all the limitations of the claimed invention were disclosed by the combination of Shoff and Fidelibus, claims 3, 5, and 9-17 are rejected.

Response to Amendment

29. Applicants' arguments filed 03/25/2004 regarding claims 1-8 (paper #6 pages 5-6) have been fully considered but they are not persuasive.

30. Applicants argued, "Shoff et al. merely describe an 'interactive' entertainment system that involves the use of both interactive supplemental content, provided by a program provider, together with continuous video programs, thereby permitting viewer interactivity with otherwise non-interactive video programs." The Office contends that Shoff et al. (Shoff) disclosed an interactive video program. For instance, Shoff disclosed, "The view computer unit also depicts a small icon or other indicia to alert the viewer that the program is interactive. The viewer can click on or otherwise activate the icon to enter the interactive mode and display the supplemental content." (Page 3 lines 14-27). "The supplemental content can be developed and provided by the same

Art Unit: 2144

provider [dedicated server] or by an independent service provide [affiliated server] (column 3 lines 9-13).

31. Shoff also disclosed in the background of the invention "computer users are familiar with interactive content on their computers. Many users own interactive multimedia CD-ROM applications that combined video, audio, pictures, text, and other content into a rich and responsive presentation (column 1 lines 47-51). Shoff further disclosed "Interactive content is also available from online services over a public network. Most notably, the Internet is emerging as a means for supplying video, sound, pictures, text, and other multimedia rich resources to a user's computer. Through the Internet, users can access a wide variety of resources that are maintained on computers located around the world."

32. In addition, the Office contends that although video stream is continuous and might appear to be non-interactive, interactive information such as pointer, Universal Resource Locators (URLs), or hyperlink information could be sent in Vertical Blank Interval (VBI) of television program or sent in another channel. Users then can interact with interactive information to link to dedicated and affiliated servers to obtain supplemental content.

33. Since Shoff disclosed the invention substantially as claimed, applicant's arguments have been considered but are not persuasive. For more details, refer to the rejection above.

34. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

Art Unit: 2144

(i.e., the dedicated server is itself integrated, in that it continually seeks additional content, in a manner personalized to user's own preferences, in order to download and make that content available to the user as well.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

35. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. England (U.S. Patent Application 6,144,991) disclosed a software system which allows users in a real-time, interactive basis over the World Wide Web.

The methodology includes configuring a guide system with a special-purpose

browser displaying both locally displayable frames and remotely displayable frames; the client system utilizes a conventional browser. The remotely displayable frames are transmitted to the client so that both the guide and the client have identical views of the remotely displayable frames. The guide uses the locally displayable frames to call upon available Web resources, typically in response to a client request also transmitted over the Web via, for example, a chat program, and then the guide can load the remotely displayable frames into the remotely displayable frames for rendering by the conventional browser. In addition, the guide and client can interact with a shared pointer and a shared whiteboard. Moreover, the guide can record the live session for later playback by other clients.

b. Boyer et al. (U.S. Patent Number 6,268,849) disclosed an Internet television program guide system is provided that allows a user at a multimedia system to access television program listings containing embedded real-time data over an Internet communications link. The television program listing may be for a sporting event that is currently being broadcast and the real-time data may be the current score of the event, the current weather where the event is taking place, or any other suitable real-time information on the event. The real-time data may be presented in the form of video stills, video clips, textual information, audio clips, or suitable combinations of such media. The user can perform database searches on the program guide listings to search for a desired program. If

desired, the user can obtain additional information on a selected program by accessing an associated web page.

c. Walker et al. (U.S. Patent Number 6,263,505) disclosed an apparatus, method, and program for providing supplemental information related to video programs. Through a computer network interface, a user can request and receive specific supplemental audio/video information related to a video program.

Alternatively, the supplemental audio/video information can be retrieved from a CD-ROM, or similar storage device. The video program can be, for example, a live broadcast television program or a time-shifted tape recording of a television program. The supplemental information is synchronized to the video program by using a time code which is integrated with the video program. This enables the supplemental information to be viewed and/or listened to in harmony with the events or action of the video program.

37. Refer to the enclosed PTO-892 for details and complete listing of other pertinent prior arts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (703) 305-4665. The examiner can normally be reached on M-F 9:00-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Art Unit: 2144

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jack Harvey
SPE
Art Unit 2142
703-305-9705

tp
April 5, 2004



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100